

REMARKS

I. Status of the Claims

Applicant submits this Amendment in reply to the Office Action dated June 20, 2008. Claims 1-12, 14, 15, 17-20, 22-34, 36-42, 45-54, and 56-64 are pending in this application, with claims 1, 22, 36, 49, 60, 61, and 62 being independent, and claims 4, 5, 7, 10-12, 15, 18-20, and 23-27 being withdrawn from further consideration. By this Amendment, Applicant has amended claims 1, 22, 36, 49, and 62, canceled claims 24-27, 54, and 56-59, and added claims 66-76. The originally-filed specification, claims, abstract, and drawings fully support the subject matter of amended claims 1, 22, 36, 49, and 62 and new claims 66-76, and no new matter has been entered.

In the Office Action dated June 20, 2008, claims 1-3, 6, 8, 9, 14, 22, 28-34, 36-42, 45-54, 56-59, and 61-64 are rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 4,543, 695 to Dorsey ("*Dorsey*"). In addition, claims 17 and 60 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Dorsey* in view of U.S. Patent Application Publication No. 2001/0044254 A1 to Gardner ("*Gardner*"). In so far as the Examiner deems the rejections to apply to the claims as amended, Applicant respectfully traverses for at least the following reasons.

II. Independent Claims 1, 22, 36, 49, and 62

Independent claims 1, 22, 36, 49, and 62 each recites, among other things, a device for treating a body canal comprising an elongated body portion including a plurality of interconnected loops and a non-loop segment, the non-loop segment

“comprising a first end directly connected to a first loop of the interconnected loops and a second end directly connected to a second loop of said interconnected loops.”

Dorsey discloses a jewelry clutch comprising a tubular shell 10 having a resilient clutch member 22 and a stud 24b adapted to be received within the resilient member 22. As shown in Fig. 8 (a figure referred to in the rejection), for example, stud 24b is inserted into resilient clutch member 22 to create an airtight joint. A chain is coupled to one end of the stud 24b and one end of the tubular shell 10. In rejecting claims 1, 22, 36, 49, and 62, the Office Action relies on a portion of stud 24b as teaching the claimed “non-loop segment.” (Office Action at pp. 2-3.) Even assuming that stud 24b of the *Dorsey* device corresponds to the claimed “non-loop segment,” a point which Applicant does not concede, *Dorsey* fails to disclose or suggest that stud 24b includes “a first end directly connected to a first loop of the interconnected loops and a second end directly connected to a second loop of said interconnected loops” as specifically required by amended independent claims 1, 22, 36, 49, and 62. In contrast, and as shown in Figs. 1-4, for example, “a chain 28 may be soldered or otherwise affixed” to a rearward portion 26 of the stud; however, blunt nose 25 is not connected to any portion of chain 28 but is inserted into mouth 16 of tubular shell 10. (*Dorsey*, col. 2, lines 53-55.)

For at least these reasons, independent claims 1, 22, 36, 49, and 62 patentably distinguish from *Dorsey*, and Applicant respectfully requests the allowance of claims 1, 22, 36, 49, and 62.

III. Independent Claim 61 and Dependent Claims 45-47

Independent claim 61 recites, among other things, a device for treating a body canal comprising an elongated body portion including a plurality of interconnected loops and a non-loop segment, the non-loop segment “made of a compressible material.”

In rejecting claim 61, the Office Action relies on stud 24b of *Dorsey* as allegedly corresponding to the claimed non-loop segment and asserts that “any solid under enough stress is compressible.” (Office Action at page 3.) However, there is no teaching in *Dorsey* that stud 24b is made of a compressible material as recited in independent claim 61. The only disclosure of a compressible material is directed to the resilient member 22, wherein “the resilient member 22 compresses as the stud is being inserted therein....” (*Dorsey*, col. 3, lines 30-33.)

Further, it is not inherent in *Dorsey* that stud 24b is made of a compressible material. For a proper inherency-based rejection, the Examiner must provide a factual basis and/or technical reasoning to reasonably support his determination that the missing feature is necessarily present in the subject matter described in the reference. In general, mere probabilities or possibilities that certain subject matter may result from a given set of circumstances are not sufficient to establish inherency. See, e.g., M.P.E.P. § 2112.

In this case, stud 24b is not necessarily made of compressible material. By simply being a solid does not necessarily mean that stud 24b is made of a compressible material.

For at least these reasons, independent claim 61 patentably distinguishes from *Dorsey* and Applicant respectfully requests the allowance of claim 61. Although of

different scope than independent claim 61, dependent claims 45-47 patentably distinguish from *Dorsey* for at least the same reasons as independent claim 61.

IV. Independent Claims 60 and 66

Independent claim 60 recites, among other things, a device for treating a body canal comprising an elongated body portion including a plurality of interconnected loops, each loop comprising a member defining an opening, "the member of each loop being biodegradable."

In rejecting claim 60, the Office Action admits that *Dorsey* "fails to disclose that the loops are made of a biocompatible material." (Office Action at page 4.) The Office Action then relies on *Gardner* for its alleged teaching of "edible materials," presumably corresponding to the biodegradable feature of claim 60. (Office Action at page 4.) However, such a rejection is improper because *Dorsey* discloses an article of jewelry and *Gardner* discloses edible toys and playthings, neither of which is analogous to the art of medical devices.

According to the M.P.E.P., a reference in a field different from that of an Applicant's invention, used as a basis for rejection, "may be reasonably pertinent if it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his or her invention as a whole." M.P.E.P., § 2141.01(a)(I) citing *KSR International Co. v. Teleflex Inc.*, 550 U.S. ___, ___, 82 USPQ2d 1385, 1397 (2007).

The article of jewelry disclosed by *Dorsey* is used as an ornamental design to be worn on the body, and the edible playthings disclosed by *Gardner* are to be played with

and eaten as food. The article of jewelry and the edible playthings clearly are not, however, in the field of Applicants' endeavor. In particular, the jewelry article and the edible playthings, for example, are not designed to be implanted in a patient's body canal, nor to minimize and preserve contact with the lining of the body canal. In addition, the problems or difficulties encountered in, for example, maintaining the patency of a body canal while simultaneously minimizing contact with the lining of the body canal, are significantly different than the problems associated with wearing an article of jewelry. For at least these reasons, one of ordinary skill in the art of medical devices would not have looked to the arts of jewelry or edible playthings to make the modifications as disclosed by the Office Action, nor would one skilled in the art have arrived at the claimed device after considering the scope and content of *Dorsey* and *Gardner*. Accordingly, the rejection is improper because the arts of jewelry articles or edible playthings are not analogous to the art of medical devices and reconsideration is respectfully requested.

Although of different scope than claim 60, new independent claim 66 patentably distinguishes from *Dorsey* and *Gardner* for at least the same reasons as claim 60.

V. Dependent Claims 2, 3, 6, 8, 9, 14, 28-34, 37-42, 48, 50-53, 63-64, and 67-76

Dependent claims 2, 3, 6, 8, 9, 14, 28-34, 37-42, 48, 50-53, 63-64, and 67-76 depend either directly or indirectly from either independent claim 1, 22, 36, 49, 60, 62, or 66 and are allowable over *Dorsey* and *Gardner* at least due to their dependence on either independent claim 1, 22, 36, 49, 60, 62, or 66.

Furthermore, *Dorsey* and *Gardner* fail to disclose many features of the pending dependent claims. For example, *Dorsey* and *Gardner* fail to disclose features of dependent claims 69-76. *Dorsey* and *Gardner* fail to teach or suggest that the end-pieces are spheres as recited in claims 69-76.

VI. Conclusion

The Office Action contains characterizations of the claims and the related art with which Applicants do not necessarily agree. Unless expressly noted otherwise, Applicant declines to subscribe to any statement or characterization in the Office Action.

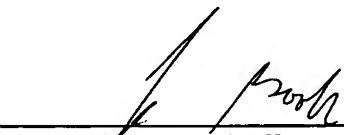
In view of the foregoing amendments and remarks, this claimed invention is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicant therefore respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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